

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID WARNER
and
RANJAN C. PATEL

Appeal No. 1997-1508
Application No. 08/489,822

ON BRIEF

Before WARREN, LIEBERMAN, and KRATZ, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 10, 14, and 16 through 18, which are all the claims pending in this application.

THE INVENTION

The invention is directed to a thermal mass transfer donor element. The element

comprises a substrate having a colorant layer wherein a fluorocarbon additive and pigment are present in specific ratios. In one embodiment, the donor element is a laser addressable mass transfer donor element. Additional limitations are described in the following illustrative claims.

THE CLAIMS

Claims 1, 6, and 16 are illustrative of appellants' invention and are reproduced below:

1. A thermal mass transfer donor element comprising a substrate having a surface colorant layer containing at least one pigment to be imagewise transferred, wherein said colorant layer comprises a fluorocarbon additive in an amount to provide a fluorocarbon additive: total pigment weight ratio from 1:20 to 1:1 and the pigment loading is in the range of 35 to 65 weight %.

6. A mass transfer imaging element comprising a substrate having a surface colorant layer containing at least one pigment to be imagewise transferred, wherein said colorant layer comprises a fluorocarbon additive in an amount to provide a fluorocarbon additive: total pigment weight ratio of at least 1:20 wherein the element is a peel-apart development element.

16. A laser addressable mass transfer donor element comprising

a substrate,

a transferable surface colorant layer on one side of the substrate wherein the colorant layer comprises a binder, at least one pigment, and a fluorocarbon additive in an amount to provide a fluorocarbon additive: total pigment weight ratio from 1:20 to 1:1

an IR absorber, wherein the IR absorber is located either in the colorant layer or in a separate layer between the substrate and the colorant layer.

THE REFERENCES OF RECORD

As evidence of anticipation and obviousness, the examiner relies upon the following references:

Bills et al. (Bills)	5,278,023	Jan. 11, 1994
Taylor, Jr. (Taylor) (published European Patent Application)	EP O 373 532 A3	Jun. 20, 1990

THE REJECTIONS

Claims 1 through 10, 14 and 16 through 18 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 6 through 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Taylor.

Claims 16 through 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bills in view of Taylor.

OPINION

We have carefully considered all of the arguments advanced by the appellants and

the examiner and agree with the examiner that the rejection of claims 16 through 18 under Section 103(a) is well founded. Accordingly, we affirm this rejection. We

agree with appellants that the balance of the rejections are not well founded. Accordingly, we reverse the rejections under Section 112, first paragraph and Section 102(b).

The Rejection Under Section 112

It is well settled that a specification complies with the 35 U.S.C. § 112, first paragraph, written description requirement if it conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventor was in possession of the invention. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); In re Edwards, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978); In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

In accordance with the instant rejection, it is the examiner's position that there is no support in the specification for the language present in each of the claims which recite the phrase, "fluorocarbon additive: total pigment weight ratio." See Answer, page 4. The examiner further explains that, "it is not clear that "the true, clear, and original intent of the phrase, 'fluorocarbon additive: pigment weight ratio' was inclusive of all the pigment." See Answer, page 6. Stated otherwise the examiner believes that there is no basis for the word "total" which was added to the claims subsequent to the filing of this application. We disagree.

The specification is directed to a mass transfer donor element which provides for specific ratios of fluorocarbon additive to pigment. See page 5, lines 17-22, and page 8, lines 18-25. We find that the pigments utilized are not limited to a single pigment, but may include mixture of components. See page 13, lines 1-30. Significantly, the appellants prepare a "Black Millbase" from a mixture of three pigments. See Example 1, page 16. Furthermore, in each of the examples, the calculated ratio of fluorocarbon: pigment is within the scope of the claimed subject matter. Based upon these findings, adequate basis exists in the specification to conclude that the appellants' invention encompasses the "fluorocarbon additive: total pigment weight ratio." Accordingly, we do not sustain the rejection.

The Rejection Under Section 102(b)

In order for a claimed invention to be anticipated under 35 U.S.C. § 102(b), all of the elements of the claim must be found in one reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is the examiner's position that, "Taylor discloses a mass transfer element comprising a substrate having thereon a colorant layer (see page 13) containing at least one pigment (Scarlet pigment) and a fluorocarbon additive (FC-430), in the recited weight ratio of fluorocarbon additive: pigment of at least 1:20." See Answer, page 4. We disagree.

We find that the lowest ratio of fluorocarbon additive: total pigment ratio disclosed

by Taylor is that found in Example 3. The ratio therein is 1:20.9. This ratio is clearly outside the scope of the claimed subject matter of 1:20. The examiner's findings, as to Example 2 on page 13, directed to a ratio of fluorocarbon additive to one of the pigments (Scarlet pigment) present in the example fails to reflect the presence of a second pigment, i.e., a magenta pigment. See Answer, page 4. The combination of both pigments results in a ratio of fluorocarbon additive: total pigment of 1:42.9. Accordingly, we cannot sustain this rejection. We further note that the only rejection before us is under Section 102.¹

The Rejection under Section 103

The sole issue presented to us with respect to this rejection pertains to the filing date of the Bills patent, i.e., November 16, 1992. It is the appellants' position that they have submitted evidence in the form of affidavits proving that the invention was made prior to November 16, 1992. See Brief, pages 8 and 9. We disagree.

As stated in MPEP, 715.04, 8th Edition, August 2001, It is well settled that in an affidavit under 37 CFR § 1.131

the following parties may make an affidavit or declaration under 37 CFR § 1.131:

- (A) All the inventors of the subject matter claimed.
- (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than

¹There is no rejection in the record before us of these claims under Section 103(a).

all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection. A party qualified under 37 § CFR 1.42, 1.43, or 1.47 in situations where some or all of the inventors are not available or not capable of joining in the filing of the application.

(C) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. Ex parte Foster, 1903 C.D. 213, 105O.G. 261 (Comm'r Pat. 1903). Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR § 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR § 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. In re Carlson, 79 F.2d 900, 902, 27 USPQ 400, 402 (CCPA 1935).

On the record before us, the affidavit under Section 131 is signed by only one of the inventors of record, i.e., Ranjan C. Patel. On the record before us, it has not been shown that Ranjan C. Patel is the sole inventor of the subject matter of claims 16 through 18. Accordingly, on this record, the appellants have not complied with the requirements of Section 131 and we sustain the rejection of the examiner.

DECISION

The rejection of claims 1 through 10, 14 and 16 through 18 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is reversed.

The rejection of claims 6 through 10 under 35 U.S.C. § 102(b) as being anticipated by Taylor is reversed.

The rejection of claims 16 through 18 under 35 U.S.C. § 103(a) as being unpatentable over Bills in view of Taylor is affirmed.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

CHARLES F. WARREN
Administrative Patent Judge

PAUL LIEBERMAN
Administrative Patent Judge

PETER F. KRATZ
Administrative Patent Judge

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